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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,801	06/14/2002	Norbert Kothe	100723- 12/Beil Wolff-291	4106
27384	7590	12/14/2004	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			SAUNDERS, DAVID A	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

030,801

Applicant(s)

KOTHE et al

Examiner

SAUNDERS

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/29/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-21, 23-26, 28-34 is/are pending in the application.
- Of the above claim(s) 23-26, 28-29, 31-32, 34 is/are withdrawn from consideration.
- ☒ Claim(s) 1-21, 30, 33 is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

The amendment filed on 9/29/04 has been entered.

The record must be clarified regarding the pending claims. Applicant urges (remarks filed 9/29/04 at page 12) that a preliminary amendment filed on 1/11/02 requested examination of claims 1-27, as the claims were amended during the international phase.

The examiner notes, first of all, that claims 1-29 were pending upon filing. The preliminary amendment of 1/11/02 directed the amending of claims 3, 5-12, 14, 16, 18, 20, 22 and 24-27 and did not explicitly direct the cancellation of claims 28-29.

Therefore claims 1-29 were correctly indicated as pending in the Office action of 3/29/04. It is noted that the response of 9/29/04 is informal for failing to indicate the correct status of claims 28-29; however, since applicant believed that these claims had never been pending, the amendment of 9/29/04 has been entered. The office considers claims 28-29 as pending and non-elected, with traverse.

Because applicant has incorrectly considered that claims 28-29 were never pending, newly presented claims 28-32 have been misnumbered. The Office, in accord with 37 CFR 1.126, has renumbered these as claims 30-34.

Newly submitted claims 23-26, 31-32 and 34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The steps of newly presented claim 31 do not require that a stepwise salt gradient be employed in the HIC fractionation. Claim 31 has apparently been presented to replace original claim 22, which depended from original claim 1, as amended on 1/11/02. Since claim 1 did then and still does require that a stepwise salt gradient, be employed,

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applicant is now claiming two inventions: 1) the invention of claim 1 and its dependents, in which the contribution over the prior art is the use of a stepwise salt gradient in the HIC fractionation, and 2) the invention of claim 31 and its dependents, in which the contribution over the prior art is a recycling of the permeate obtained in the HIC fractionation. Since there is not unity of invention in terms of a single contribution over the prior art, and since the second invention embodied by new claim 31 and its dependents was not searched, claim 31 and its dependents are properly withdrawn.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-26, 31-32 and 34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Following entry of the amendment of 9/29/04, claims 1-21, 23-26, and 28-34 are pending. Claims 1-21, 30, and 33 under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment of 9/29/04 has overcome the previously stated objection to the specification, the objection to claim 2 under 37 CFR 1.75(c), the objection to the claims under 37 CFR 1.75 (i), and the rejection of claims 1-21 under 35 USC 112, second paragraph.

Applicant's urgings of 9/29/04 have overcome the previously stated rejection under 35 USC 103 of the claims over Goheen et al in view of Goudswaard et al. It is

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noted that applicant's claimed method is drawn to obtaining and immunoglobulin – containing ~~and~~ an albumin –containing fraction, while Goudswaard et al's teachings are directed to obtaining an IgG (T) – containing and an IgA – containing fraction. There is thus no motivation to apply the teachings of Goudswaard et al to those of Goheen et al. Claims 1-21, 30 and 33 are allowable over the prior art of record.

This application is in condition for allowance except for the presence of claims 28-29 are to an invention non-elected with traverse in the reply filed on 11/12/03. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

In any response canceling non-elected claims 28-29, claims 23-26, 31-32 and 34 which are non-elected by original presentation, likewise be cancelled.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Saunders whose telephone number is (571) 272-0849. The examiner can normally be reached on Monday to Thursday from 8 AM to 5:30 PM and on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Saunders/LR
December 6, 2004

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
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